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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,202

06/23/2005

Masao Mori

123647

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25944

7590

09/26/2007

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EXAMINER

CUTLIFF, YATE KAI RENE

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

09/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,202	Applicant(s) MORI ET AL.	
	Examiner Yate' K. Cutliff	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 5-7 & 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see response, filed July 23, 2007, with respect to the rejection(s) of claim(s) 1 and 8 under 102(b), and claims 1, 3, 4, 8, 10, and 11 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Applicant's response.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

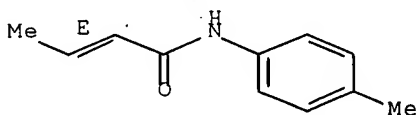
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fichter, Fr., et al. "Studies on Unsaturated Acids. V. On Crotonyltoulenediamine", 1907, Journal de Phsiologis, vol. 74, Abstract from CAPLUS.

Rejected claim 1 claims a compound of formula (I).

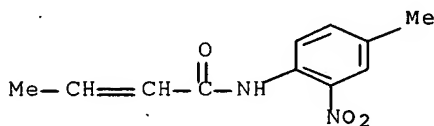
Fichter et al. discloses the following species:



The compound anticipates claim 1 when X=NH, Y= a vinyl substituted by a methyl, Z= a phenyl substituted by a methyl.

Rejected clam 8 claims a compound of formula (I')

Fichter et al. discloses the following species:

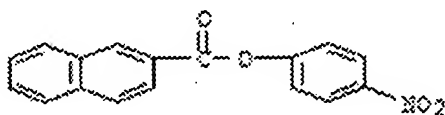


The compound anticipated claim 8 when X=NH, Y' = vinyl substituted by a methyl and Z represents a phenyl substituted by methyl and nitro.

4. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Barra, M., et al., "Inhibition of hydrolysis of p-nitrophenyl esters by association with an erythromycin A derivative", 1992, Journal of Chemical Research, Synopases, vol. 7, Abstract from CAPLUS.

Rejected clam 8 claims a compound of formula (I')

Barra et al. discloses the following species:

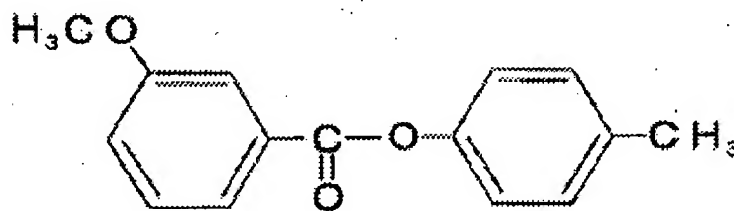


The compound anticipates claim 8 when X=O, Y' = naphthyl group, Z= a phenyl substituted by nitro.

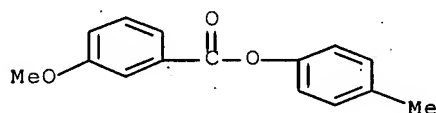
5. Claims 1, 4, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kulickova, et al. "Physicochemical Study of 3'- and 4'-substituted 2-hydroxy-5-methylbenzophenone", 1979, Chemick Zvesti, vol. 33(5), Abstract from CAPLUS.

Applicant claims the compounds of general formulas (I) and (I'). See brief description in the 102(b) rejections of paragraphs 3 and 4 above.

Rejected claims 4 and 11 claims the following compound:



Kulickova et al discloses the following compound:



The prior art disclosed the claimed compound.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

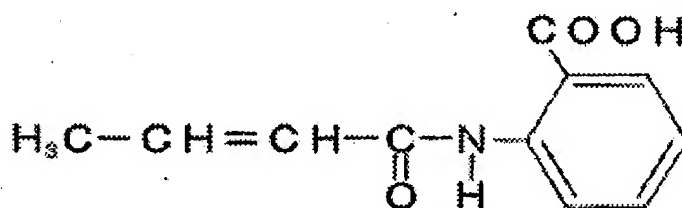
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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehead, C., "Diuretics. Organomercuricals", 1958, Journal of the American Chemical Society, vol. 80, pp 2179, 2181-2182.

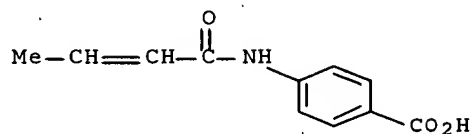
Applicant claims the compounds of general formulas (I) and (I'). See brief description in the 102(b) rejections of paragraphs 3 and 4 above.

Applicant, in rejected claims 2 and 9, claims the following compound:



Whitehead teaches the process of making the following compound, then use of the compound in formulation of pharmaceutical grade diuretics.

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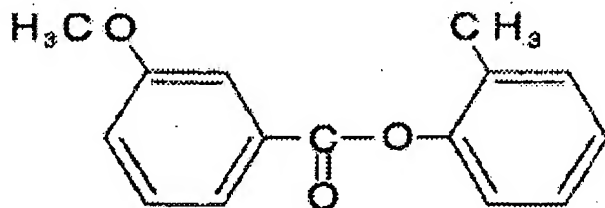
The compound of Whitehead substantially discloses the claimed compound except, that the carboxyl group is para the "NH" versus being ortho as set out in Applicant's claims 2 and 9.

However, since the prior art discloses that the compound has a useful purpose, therefore, one skilled in the art would presume that a compound having a similar structure (para carboxyl group) would have a similar utility. Evidence of any similar properties or evidence of any useful properties disclosed in the prior art that would be expected to be shared by the claimed invention weights in favor or a conclusion that the claimed invention would have been obvious. Dillion, 919 F2d at 697-98, 195 USPQ2d at 1905 (Fed. Cir. 1990).

10. Claims 1, 3, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hideo, S. (JP 58-157884).

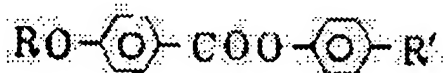
Applicant claims the compounds of general formulas (I) and (I'). See brief description in the 102(b) rejections of paragraphs 3 and 4 above.

Applicant, in rejected claims 3 and 10, claims the following compound:



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Hideo discloses the following compound:



Hideo teaches that the composition is a liquid crystal composition, where R & R' = 1-12 C alkyl. The composition is capable of reducing the driving voltage, and suitable for twisted nematic liquid crystal display of time sharing driving method. The Hideo lacks the express teaching that the methoxy group is meta the C=O, while the methyl group is ortho the oxygen.

However, since the prior art discloses that the compound has a useful purpose, therefore, one skilled in the art would presume that a compound having a similar structure would have a similar utility. Evidence of any similar properties or evidence of any useful properties disclosed in the prior art that would be expected to be shared by the claimed invention weights in favor of a conclusion that the claimed invention would have been obvious. Dillion, 919 F2d at 697-98, 195 USPQ2d at 1905 (Fed. Cir. 1990).

Therefore, the inventions of claims 2, 3, 9 and 10 as a whole are *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Allowable Subject Matter

11. Claims 5 - 7, and 12 - 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The following is a statement of reasons for the indication of allowable subject matter: The closest prior art Baudet (WO 92/19223) discloses phenyl-cinnamide derivatives however it fails to disclose or suggest the compounds of claims 5-7 or the ultraviolet ray protection agent as set out in Claims 12 - 14.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.11 I(b) and MPEP § 707.07(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yate' K. Cutliff whose telephone number is (571) 272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272 - 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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